

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

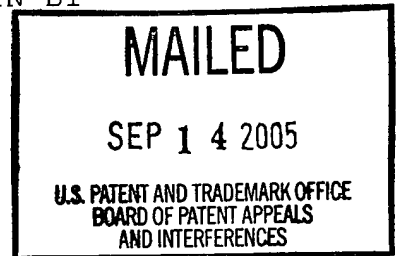
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUYUKI KAMBE and XIANGXIN BI

Appeal No. 2005-0056
Application No. 09/841,255

ON BRIEF



Before GARRIS, WARREN and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is hereby remanded to the examiner for action consistent with our comments below.

As the examiner is aware, this application is related to application serial no. 09/136,483 and application serial no. 09/433,202.¹ Like the present application, these related

¹The subject appeal includes obviousness-type double patenting rejections based on the claims of these related applications.

Appeal No. 2005-0056
Application No. 09/841,255

applications included prior art rejections based on U.S. Patent No. 5,389,194 to Rostoker et al. which were appealed to the Board of Patent Appeals and Interferences. As in the subject appeal, the appeals of these related applications raised issues concerning the meaning of patentee's quality factor "Q" (e.g., see the disclosure at lines 4-26 in column 7) and concerning whether the patent disclosure would enable practice of the invention defined by the claims under rejection. The subject appeal also raises corresponding issues with respect to rejections based on U.S. Patent No. 5,626,715 to Rostoker. Because the appeal now before us and the related application appeals involve common issues, recent developments in the latter are relevant to our disposition of the former.

As background, the rejections based on Rostoker et al. '194 in the related application appeals were affirmed based on, inter alia, analyses involving exemplificative calculations made by the Board to assist in its interpretation of the above noted patent disclosure vis-à-vis quality factor "Q" (i.e., particle size distribution). For the reader's convenience, we attach hereto copies of the Board decisions containing these analyses and calculations, that is, the decision mailed February 27, 2003 for appeal no. 2001-1031 in application serial no. 09/136,483 and

Appeal No. 2005-0056
Application No. 09/841,255

the decision mailed June 23, 2004 for appeal no. 2004-1233 in application serial no. 09/433,202. In response to these decisions, respective requests for rehearing were filed and included a declaration under 37 CFR § 1.132 by Professor Singh bearing the execution date of December 10, 2001 as evidence rebutting the Board's analyses/calculations and concomitant interpretation of the Rostoker et al. patent disclosure. This declaration was denied entry by the Board panel for appeal no. 2001-1031 in application no. 09/136,483, and an appeal to the U.S. Court of Appeals for the Federal Circuit followed. In its decision, the court held this entry-denial to be erroneous and consequently vacated the Board's decision and remanded the application for appropriate further proceedings. Again for the reader's convenience, we attach hereto a copy of the court decision, that is, In re Sujeet Kumar et al. (CAFC, 04-1074, 8/15/2005). In view of the court decision in application no. 09/136,483, the Board vacated its decision in application no. 09/433,202 and remanded this application to the examiner for appropriate further proceedings. A copy of this last mentioned remand (which is entitled "ON REQUEST FOR REHEARING") is attached hereto.

These developments in the related application appeals are germane to the appeal now before us for a number of reasons. As earlier mentioned, the instant appeal presents rejections based on Rostoker et al. '194 and issues concerning the aforementioned column 7 disclosure of this patent. This appeal also presents rejections based on Rostoker '715 which raises these same issues since column 6 of this patent contains the same disclosure as in column 7 of the '194 patent. Therefore, it is necessary that we remand this application to the examiner for consideration of the Board's interpretation based on its analyses and calculations of the aforementioned patent disclosure. As explained by the Federal Circuit in its Kumar decision, this consideration must be made by reviewing the entirety of the relevant evidence of record in order to determine whether the here claimed invention as a whole is patentable over the '194 and '715 patents.² Kumar, id. at page 12. At the examiner's discretion, a supplemental answer may be used to effect this review.

An additional matter of concern warrants discussion. Our study of the brief, answer and reply brief reveals that the appellants and the examiner appear to be in dispute as to whether

²The relevant evidence of record in this application appears to include the previously discussed declaration by Professor Singh executed on December 10, 2001.

certain argument and evidence have been properly advanced in this appeal. For example, in the paragraph bridging pages 12 and 13 of the answer, the examiner urges that the appellants' nonenablement discussion on pages 27 through 29 of the brief concerns the prosecution history of the parent application and that "the prosecution history of the parent application does not show non-enablement of the [Rostoker '194 and '715] patents since none of the arguments presented in the parent application have been made in this application and the declaration discussed has not been presented as evidence in this application" (answer, page 12). Further in this regard, the examiner states that "Appellants' summary of the prosecution history of the parent leaves out the fact that the Examiner cited a patent showing filtering of nanosized colloidal particles using filters having a mesh size of 2-1000 nm were known in 1989 in the office action of 25 August 2000 rebutting Dr[.] Singh['s] declaration that such filters were not known in the art as of 1997" (answer, page 13). In their reply brief, the appellants express disagreement with the examiner's position that the above noted argument and evidence concerning nonenablement have not been properly presented in the subject application and appeal (see pages 6-7). With respect to the examiner's aforementioned statement regarding

Appeal No. 2005-0056
Application No. 09/841,255

her citation of a patent in the parent, the appellants state that "Applicants could not find a reference to such a patent in the Office Action of August 25, 2000" (reply brief, pages 6-7).

This type of exchange between an appellant and an examiner does not serve to crystallize issues on appeal. For example, it is simply irrelevant to this appeal whether the examiner did or did not cite a patent in the parent application as rebuttal to a nonenablement argument in the parent. This is because the examiner in her answer for this appeal has not proffered (or even identified) the patent in question as evidence supporting her position. With this last mentioned point in mind, we emphasize to both the appellants and the examiner that all arguments and evidence advanced on this appeal in support of their respective positions must be contained in their briefs and answers. See our former regulations at 37 CFR §§ 1.192 through 1.193 and our current regulations at 37 CFR §§ 41.37 through 41.43. Therefore, in response to this remand, both the appellants and the examiner should take whatever steps are necessary to ensure that their respective briefs and answers contain all argument and evidence they desire to advance on this appeal.

Appeal No. 2005-0056
Application No. 09/841,255

In this latter regard, the appellants' brief filed February 12, 2004 may be defective. Specifically, this brief as reproduced in the Image File Wrapper (IFW) for the subject application does not include as attachments all of the appendices referred to in the body of the brief. That is, in the brief, the appellants make reference to a total of 10 appendices A through J whereas only 6 appendices are associated with the IFW brief before us on this appeal. Accordingly, in responding to this remand, the examiner must verify whether the brief filed February 12, 2004 is indeed defective in the manner described above (e.g., by conferring with the appellants' attorney of record) and, if so, must take whatever steps are necessary to rectify this defect (e.g., via a notice of defective brief). If the brief is not defective which is to say if the IFW for this application is incomplete, the examiner must take whatever steps are necessary to ensure that the IFW is corrected to include all brief attachments.

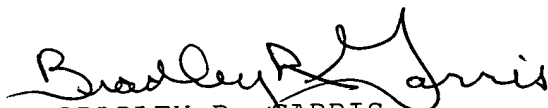
This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR

Appeal No. 2005-0056
Application No. 09/841,255

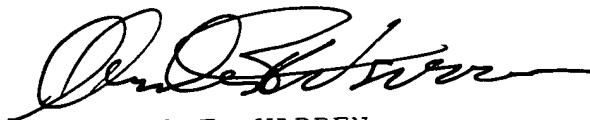
§ 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

This application, by virtue of its "special" status requires an immediate action; see the Manual of Patent Examining Procedure (MPEP) § 708.01(D) (8th Ed., Rev. 2, May 2004). It is important that the Board be promptly informed of any action affecting the appeal in this application.

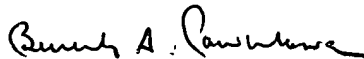
REMANDED



BRADLEY R. GARRIS
Administrative Patent Judge



CHARLES F. WARREN
Administrative Patent Judge



BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

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Appeal No. 2005-0056
Application No. 09/841,255

PETER S. DARDI
PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100